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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,167

03/10/2004

Roger D. Graham

2925.003

4058

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/797,167

Applicant(s)

GRAHAM, ROGER D.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3-04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 3-10-04.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooley et al. (US 5,616,902).

Re claim 1, Cooley et al. teaches transmitting a bill to a customer from a biller, the bill having a code encoded in a readable encoding region, the bill code identifying customer information and a payment amount (FIG.3), reading the bill code with a bill reader to collect the customer information and the payment amount, receiving cash by for at least the payment amount and causing payment of the bill from a bank to a bank associated with the biller (FIG. 5, which teaches that the code is read to collect customer and payment information, cash is received, and then payment is made from the office/bank 89 and then transferred to the biller bank/accounts of the billers/issuers. Though Cooley et al. is silent to a third party, the Examiner notes that as the machine is able to handle various issuers/billers, that the money is taken to an office/bank 89 and then transferred to issuers/billers accounts (versus just taken to the issuers/billers themselves), and can be located at a grocery store, it would have been obvious to

be operated by a third party, as a means of providing a service to consumers (convenience) for paying bills.

Re claim 2, the bill reader is disclosed as being able to be positioned at a grocery store, bank lobby, offices, travel offices, bus, train terminals, convenient stores, and other places where personnel are present to keep an eye out (col 7, lines 50+), it would have been obvious to position it at/near a point of sale terminal, to provide a convenience to a user, by positioning it near a device where financial transactions take place, to encourage use, and to gain a lot of attention by those who pass by (high travel location).

Re claim 3, as the funds are transferred, as discussed above, it would have been obvious to transmit a bill pay order to the first account to send funds from the first bank to the second bank.

Re claims 4 and 9, the Examiner notes that the fields of the barcode do not teach information relating to the identity/demographic information of the bill payer. However, the Examiner notes that in order for information to be posted to the users specific account, that inherently a link exists between the users name or other demographic information required to finalize a transaction, and the information encoded in the barcode 42. Accordingly, at one point it is envisioned that a link must be established and information regarding the name, address, etc. (demographic information) must be downloaded to process payment.

Re claim 5, the Examiner notes that if the machine accepts bill payment, it would have been obvious for the bill payer to designate to the user that such transactions can occur, in order to provide advertising and also convenience to the user, so that the user knows that they can make payments in a different way than just mailing them in. The claims do not specifically

recite that the means is designated by text printed on the bill, for example. The mere fact that the site accepts payment, it is understood to have been designated by the biller, otherwise it would not accept such payment had the biller not designated it.

Re claims 6-8, and 10-11, the limitations have been discussed above.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustin et al. (US 6,012,048) in view of Cooley et al., as discussed above.

Re claim 12, Gustin et al. teaches a method comprising at least two business transactions with a customer by a third party each of the transactions including at least the purchase of an item and payment of a bill provided by a biller, both by cash inserted into the device, (FIG. 9 which shows that money orders and lottery tickets, stamps, and phone cards can be purchased, and bills paid), where bills are scanned by scanner 54. Though silent to reading a code, the scanner is able to read information from the bill, and it would have been obvious that codes are provided on bills, especially in light of the prior art cited above, as a means to provide machine readable indicia for accuracy in reading and processing. The Examiner notes that though silent to storing item identification, customer identification, and providing a profile/record of the transactions of the cash paying customer based on the stored identifications of the items purchased, it is well known and conventional in the art that ATM and other banking/sales devices record transactions (electronically) for record and log keeping. Accordingly, the limitations relating to recording keeping and providing a profile/record based on the transactions is an obvious expedient, obvious to one in the art, to record and sort/organize data.

Re claims 1-12, the limitations of Gustin et al. have been discussed above.

Gustin et al. is silent to the bill having a bill code encoding customer information and payment amount.

Cooley et al. teaches such limitations as discussed above.

It would have been obvious to combine the teachings of Gustin et al. with those of Cooley et al.

One would have been motivated to do this to provide machine-readable means to readily gather bill information from a bill for improved accuracy.

The Examiner notes that the banking device of Gustin et al. is interpreted as a third party, and as funds are transferred, it would have been obvious to do them electronically, from one account to another. As the banking device is able to sell items, it is also interpreted as a point of sale device. Further, as payment is processed by the banking machine to the bill payment companies, it would have been obvious to transmit a bill pay order to the bank associated with the third party, as a means to transfer the funds to the biller. Designation of the site is understood to occur, as the banking device must be designated by the biller to be in a cooperative relationship to permit bill payment.

Additional Remarks

4. The Examiner notes that claim 12 does not specifically recite that the transactions performed are both cash transactions, but only that the customer is described as one who conducts cash transactions. Thus, a customer can perform cash transactions (other transactions), without the transactions of the claim being cash transactions. For example, a customer can perform cash transactions, and in other instances, can perform non-cash transactions.

Conclusion

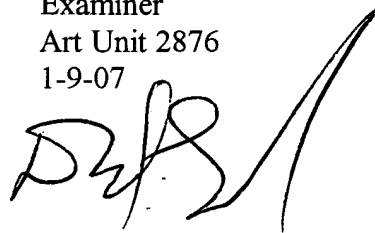
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel I Walsh
Examiner
Art Unit 2876
1-9-07

A handwritten signature in black ink, appearing to read 'DW', with a long, sweeping horizontal stroke extending to the right.

DANIEL WALSH
PRIMARY EXAMINER